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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/133,982 10/08/93 YURT

26M1/0809

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WASHINGTON, DC 20005-3315

EXAMINER

LE, A

ART UNIT	PAPER NUMBER
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6

2614
DATE MAILED:

08/09/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 05/13/94 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|-------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

- ☒ Claims 21-49 are pending in the application.
- Of the above, claims _____ are withdrawn from consideration.
- ☒ Claims 1-20 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 21-49 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Information Disclosure Statement

1. The information disclosure statement filed on 01/04/94 fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.

Specification

2. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the term "recognizing" and "disabling" in claims 27 and 31 do not appear in the specification.

Claim Rejections - 35 USC § 112

3. Claim 39 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 2, the recitation "the central processing station" lacks proper antecedent basis.

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Double Patenting

4. Claims 21, 22 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,132,992. This is a double patenting rejection.

The omissions of the ordering means, the compression means, the compressed data storing means (claims 21, 22 of the present application) do not change the fact that the claimed systems of the present application are still covered by that of the conflicting patent claims. In re Schneller (CCPA) 158 USPQ 210.

5. Claims 23-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 31 of U.S. Patent No. 5,132,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because

a. Regarding claims 23, 24, the inclusion a plurality of library means being geographically separated would have been obvious in a transmission system involving the use of a plurality of stations.

b. Regarding claims 25, 26, 28, 29 the "off line recording media" storing means has the same "playing back" purpose as the "output data conversion means" of the patented claim 3's system.

c. Regarding claims 27 and 31, the "recognizing protected data" and "disabling the storage" is only a language variation of

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the conflicting patent's "copy protection means for preventing copying of the protected information".

6. Claims 32-35, 46-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 19 and 20 of U.S. Patent No. 5,132,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because given the disclosure of the system claimed in the conflicting patent, it would have been obvious to one of the ordinary skill in the art to combine the teachings in the two claims to implement a communication system having all the characteristics of a transmission, distribution, and receiving system.

7. Claims 36-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 5,132,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because "audio/video information at a non-real time rate" is also a form of "formatted data" and "transmitting" is an obvious alternation of "playing back".

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8. Claims 40 is rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 25 of prior U.S. Patent No. 5,132,992. This is a double patenting rejection.

The omissions of decompressing process does not change the fact that the claimed systems of the present application are still covered by that of the conflicting patent claims. In re Schneller (CCPA) 158 USPQ 210.

9. Claims 41-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 25 of U.S. Patent No. 5,132,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the followings:

a. Regarding claims 41, 42, the same functionally processes are being performed in a different environment.

b. Regarding claims 43-45, the claimed structure is an obvious combination of the system described in claims 1 and 25 of the conflicting patent.

10. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Le whose telephone number is (703) 305-4769. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703)305-4714.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Amanda Le

Amanda Le

August 05, 1994

Young Tse
YOUNG TSE
PATENT EXAMINER
GROUP 2600

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